



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,765	02/28/2002	Robert D.P. Hei	163.1587US01	8789

23552 7590 08/18/2003

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 08/18/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,765

Applicant(s)

HEI ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-20, 23, 24, 26, 27, 35, 36, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22, 25, 28-34, 37 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 48 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "substantially cosolvent-free" and "surfactant-free" in claims 48,49 line 2 are relative terms which render the claims indefinite. The terms "cosolvent-free" and "surfactant-free" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is meant by the terms?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21,22,25,28-34,37,40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajoku et al (WO 0004777; 2/3/00) in view of JP 06219911; 8/9/94). Ajoku teaches an antimicrobial composition that can be in the form a concentrate comprising peracetic acid (peroxy acid) and water (diluting solvent). Ajoku teaches that

Art Unit: 1616

the composition is used in industry to control slime. See abstract, page 1 paragraph 1, page 2 1st full paragraph – page 4 1st full paragraph, page 6 3rd full paragraph, page 10 1st full paragraph, claims 1,4, 5. Ajoku does not teach the composition comprising dimethyl adipate. However, JP '911 teaches an antimicrobial composition comprising 15 wt % dimethyl adipate (ester) and 55 wt % dimethyl glutarate (ester). Therefore, JP '911 teaches a total ester content of 70 wt % which is about 75% ester as instantly claimed. JP '911 teaches that the composition is used in industry to control slime. See abstract. It would have been obvious at the time the invention was made to modify the composition / concentrate taught by Ajoku to include the dimethyl adipate taught by JP '911. One would have been motivated to do since both prior art antimicrobial compositions are individually used to control slime in industry. Note that claims 42-44 are to the solubility of dimethyl adipate in water which in actuality is an inherent property of esters (dimethyl adipate) in Applicant's invention.

Restriction / Election Status

Based on Applicant arguments, Examiner has reduced restriction requirement to consist of two groups: Group I claims 1-20 and Group II claims 21-49. Based on Group elected by Applicant in previous response (paper no. 7), Examiner deduces that the election of Group II is maintained. Examiner disagrees with the combining of the present Group I and Group II. Groups I and II are distinct, because the search for Group I is different from the search required by Group II. For this reason the present Restriction is Final.

Art Unit: 1616

Examiner acknowledges that Applicant elects ester and peroxy acids. In reply to this official action, Examiner is requesting the election of a single specific ester compound and a single specific peroxy acid compound. If Applicant desires additional ingredients (usually in further comprising claims), Examiner is requesting that Applicant specifically name or define additional desired ingredients. If additional ingredients are not specifically named or defined, Examiner will consider claims having unspecified additional ingredients as withdrawn from examination. Based on the art rejection above, the generic election is not allowable.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.



Alton Pryor
Patent Examiner
AU 1616

**ALTON N. PRYOR
PRIMARY EXAMINER**